



PATENT  
Customer No. 22,852  
Attorney Docket No.: 05725.1234-00000

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:	)	
	)	
Florence TOURNILHAC	)	
	)	
Application No.: 10/632,897	)	Group Art Unit: 1616
	)	
Filed: August 4, 2003	)	Examiner: Melissa Mercier
	)	
For: COMPOSITION GELLED WITH A	)	Confirmation No.: 7929
DEXTRIN ESTER	)	
	)	
	)	

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENT**

In an Office Action dated April 19, 2006, the Examiner requires restriction between certain groups of claims as set forth below as well as various elections of species. This paper is filed in response to those requirements. The period for response to the Office Action has been extended three months to August 19, 2006, by the Petition for Extension of Time for three months and fee filed concurrently herewith.

***Restriction Requirement***

The Examiner requires restriction under 35 U.S.C. § 121 between the following groups of claims:

Group I: Claims 1-88, drawn to a composition, classified in class 424,  
subclass 400; and

Group II: Claims 89-102, drawn to a method of use, classified in class  
424, subclass 401.

See Restriction Requirement at page 2.

Applicant respectfully traverses the restriction requirement, as it is set forth  
above and on pages 2- 7 of the Restriction Requirement. However, to be fully  
responsive, Applicant elects, with traverse, the subject matter of Group I, claims 1- 88.

The Examiner states that Group I is distinct from Group II. See Restriction  
Requirement at 7. The Examiner asserts that Group I is distinct from Group II because  
the composition of Group I has utility other than cosmetic composition, such as  
lubricants. Applicants respectfully refer the Examiner to M.P.E.P. § 803, which sets  
forth the criteria and guidelines for Examiners to follow in making proper requirements  
for restriction. The M.P.E.P instructs the Examiner as follows:

If the search and examination of an entire application can be  
made **without serious burden**, the Office **must** examine it  
on the merits, even though it includes claims to independent  
or distinct inventions.

M.P.E.P. § 803 (emphasis added).

Here, the Examiner has not shown that examining Groups I and II together would  
constitute a serious burden. Additionally, Applicants respectfully submit that examining  
the composition and a process of using the composition should not impose a serious  
burden on the Examiner. Indeed, a search for the composition should overlap the  
search for the process given the common classification that will occur due to the

election of species discussed below. Finally, Applicants submit that no serious burden would exist in light of the requirement of rejoinder. See M.P.E.P. § 821.04.

Accordingly, it is unclear what burden is on the Examiner to examine all groups together, and Applicants respectfully request withdrawal of the restriction requirement.

***Election of Species***

The Examiner also requires three elections of species:

(1) The Examiner requires an election of one species for formula (1) recited in claim 7. See page 4 of the Office Action.

(2) The Examiner requires an election of the species of oils. Specifically, the Examiner election of one of the categories of oils in claim 60. *Id.*

(3) The Examiner requires an additional election of the form of the claimed invention. Specifically, the Examiner requires election of one of the forms in claim 85. *Id.* Per a telephone conference with the Examiner on May 17, 2006, this election of species is required for Group I, not Group II as indicated in the Office Action. Applicant thanks the Examiner for this clarification.

Accordingly, Applicant elects, with traverse:

(1) the species of formula (1) wherein  $R_1$  is R-CO-,  $R_2$  is R-CO-, and  $R_3$  is H;

(2)  $C_4$  to  $C_{22}$  fatty acid ester oils; and

(3) the lipstick form.

Applicants disagree with the election requirement and remind the Examiner that if she chooses to maintain the election of species requirement, Applicants expect her, if

the elected species is found allowable, to continue to examine the full scope of claims 1-88 to the extent necessary to determine the patentability of these pending claims, *i.e.*, extending the search to a reasonable number of the non-elected species, as is the duty according to M.P.E.P. § 803.02 and 35 U.S.C. § 121.

**Conclusion**

In view of the foregoing remarks, Applicant requests timely examination of the claims. Please grant any extensions of time required to enter this response and charge any required fees not otherwise provided for to our Deposit Account No. 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: July 27, 2006

By: 

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